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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/042,625	01/09/2002	Francis Ambrose Broderick	FR920000074US1	4352

45092 7590 08/19/2009

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ART UNIT	PAPER NUMBER
3624	

NOTIFICATION DATE	DELIVERY MODE
08/19/2009	ELECTRONIC

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/042,625
Filing Date: January 09, 2002
Appellant(s): BRODERICK ET AL.

Meghan Q. Toner
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 21, 2009 appealing from the Office action mailed March 25, 2009.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The Examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

- Alter, Steven; Information Systems: A Management Perspective, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996 (herein Alter).
- Lacity, Mary; Willcocks, Leslie P.; "An Empirical Investigation of Information Technology Sourcing Practices: Lessons from Experience", MIS Quarterly, Sept. 1998 (herein Lacity).
- Willcocks, Leslie; Choi, Chong; "Co-operative Partnership and 'Total' IT Outsourcing: From Contractual Obligation to Strategic Alliance?", European Management Journal, March 1995 (herein Willcocks).

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1 and 4 – 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Alter, Steven; *Information Systems: A Management Perspective*, 2nd Edition, The Benjamin/Cummings Publishing Company, 1996 (herein Alter), in view of Lacity, Mary; Willcocks, Leslie P.; "An Empirical Investigation of Information Technology Sourcing Practices: Lessons from Experience", MIS Quarterly, Sept. 1998 (herein Lacity), further view of Willcocks, Leslie; Choi, Chong; "Co-operative Partnerhip and 'Total' IT Outsourcing: From Contractual Obligation to Strategic Alliance?", European Management Hournal, March 1995 (herein Willcocks).

Claim 1

Alter teaches the following limitations:

- *defining a project business need, the project business need being discrete and having a fixed duration* (see pp. 552-553 and 558-559; where information systems plans are linked to a company's business plan. The critical success factors include business needs such as improving customer relationships, improving supplier relationships, making the best use of inventory, and using capital and human resources efficiently and effectively. Furthermore, these business needs are broken down into business processes and can be reengineered. The project is discrete and deadline and completion dates are set, thus the project has a fixed duration.);
- *defining a project technical need, the project technical need involving resources needed to realize the project business need* (see pp. 552-553; where specific

technical needs are determined and defined. The technical needs are resources that are needed to complete the project.);

- *determining, according to the project business need, a number of IT sites spread over a geographic area* (see pp. 551-559 and 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines. The data centers are determined in accordance to the business needs.);
- *determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area* (see pp. 551-559; where distinct roles are assigned to specific personnel who have the requisite skill set to perform the assigned tasks. The specific personnel are determined based on the technical requirements of the IS plan.);
- *grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area* (see pp. 557 and 564-65; where skilled personnel and grouped in to general roles. Equipment and personnel are distributed based on technical constraints. The technical constraints include decentralized systems that account for local variances versus centralized systems that perform cross-departmental functions well).
- *listing processes and methods used in the IT sites as determined* (see pp. 559 and 565-566; where corporate standards and procedures are determined);

- *listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed* (see pp. 570-574; where assessment of efficiency is determined using multiple standards and procedures);
- *creating with a graphic user interface an evolutionary image of the values of the criteria* (see p. 573; where a graph displaying costs, benefits and cumulative net benefit is created for a project);
- *determining best processes and methods according to values of said criteria* (see pp. 565-566 and 570-574; where best practices are determined and implemented and can be based on efficiency),
- *analyzing the image for determining the best processes and methods* (see p. 573; where the image is analyzed to determined the value of the project).
- *implementing the best processes and methods in the IT sites as determined* (see pp. 565-566 and 570-574; where best practices are determined and implemented and can be based on efficiency).
- *entering in a database the values of said criteria* (Prior Art of Record. See MPEP § 2144.03 for procedures regarding timely traversal of Official Notice.).

Alter fails to explicitly teach "physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities, which include cultural differences, language differences, and legal

constraints". Lacity, in an analogous art, teaches "physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities" (see Lacity pp. 373, 376, and 384; where IT data centers (site) were consolidated in order to reduce costs.). Lacity fails to explicitly consider "cultural differences, language differences, and legal constraints" in its consolidation. Willcocks, in an analogous art, explicitly teaches "cultural differences, language differences, and legal constraints" in consolidating and outsourcing (see Willcocks pp. 69-71; where cultural differences, language differences, and legal constraints are considered in outsourcing.). The advantage of such a feature that it facilitates the success of an IS outsourcing plan. It would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine the feature of "physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities, which include cultural differences, language differences, and legal constraints" taught by Lacity and Willcocks to Alter in order to facilitate the success of the IS outsourcing plan, which is a goal of Alter (see Alter p. 552).

Claims 4 and 5

The combination of Alter/Lacey/Willcocks fails to explicitly teach the following limitations, however the examiner takes **Official Notice** to:

- *repeating the steps of listing criteria, determining best processes and methods, and*
- *implementing the best processes and practices.*

It is old and well known in the art to repeat steps in a process. The advantage of repeating steps is to ensure the accuracy and consistency of results due to performing the steps of the process. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to repeat the steps of the process in order to ensure the accuracy of the results of the steps, which is a goal of Alter (see p. 570).

Claim 6

The combination of Alter/Lacey/Willcocks teaches the limitations as claimed above. Furthermore, Alter teaches the following limitation:

- *IT sites are spread over more than one geographic area* (see pp. 564-565; where IT sites have data centers. Data centers can be located at the corporate headquarters, regional processing centers, site processing centers, department processors, workgroup processors, or at individual client machines.).

Claim 7

The combination of Alter/Lacey/Willcocks teaches the limitations as claimed above. Furthermore, Alter teaches the following limitation:

- *further comprising a step of determining, before the step of determining skilled people groups and computer equipment, a management organization for the*

geographic area (see p. 557; where project manage roles are assigned. Each IS department or region is accounted for).

Claim 8

The combination of Alter/Lacey/Willcocks teaches the limitations as claimed above. Furthermore, Alter teaches the following limitation:

- *further comprising after each step, a step of updating a project management tool displaying a time for executing each step of the method of claim 1* (see p. 576; where a Gantt chart is a tool used to display a time for executing steps of a project).

(10) Response to Argument

Appellant argues:

i) Alter fails to teach or suggest defining a project business need, the project business need being discrete and having a fixed duration.

ii) Alter fails to teach or suggest determining best processes and methods according to values of said criteria by analyzing and manipulating the image using the graphic user interface.

iii) Alter fails to teach or suggest determining, according to the project business need, a number of IT sites spread over a geographic area and determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area.

iv) Appellants respectfully submit that there is no motivation or suggestion to combine Alter with Lacity and Willcocks to teach or suggest physically consolidating the IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of skilled people groups and geographic site location peculiarities, which include cultural differences, language differences and legal constraints.

*** Appendix A has been provided as a quick reference; where the claimed features of the instant invention have been mapped to the prior art as applied in the rejection under §103.**

As to argument i), that Alter fails to teach or suggest defining a project business need, the project business need being discrete and having a fixed duration the Examiner respectfully disagrees. The Examiner addressed this limitation in **Claim 1** *supra*. Alter explicitly discloses defining a discrete project business need (*inter alia* on page 552 a "new sales tracking system" is a discrete project business need) having a fixed duration (noting, page 552 "when they do it, to produce the specific results needed in a specific project". Further noting, page 553, "completion dates". Having a plan of what tasks are completed when and when the project and tasks are completed demonstrates that the project has a fixed duration.).

As to argument ii), Alter fails to teach or suggest determining best processes and methods according to values of said criteria by analyzing and manipulating the image using the graphic user interface, the Examiner respectfully disagrees. The Examiner addressed this limitation in **Claim 1** *supra*. As noted by the Examiner, Alter discloses on page 572 manipulating "different staffing levels" (i.e. manipulating an input variable) and on page 573 analyzing, using an exemplary GUI, to determine the "cost incurred", "benefits attained" and "net benefits" in dollars at the different staffing levels (i.e. analyzing the image using the graphic user interface).

The Examiner also notes that this claim limitation was interpreted properly in light of the specification (p. 32, lns. 20-25), wherein the step of manipulating the image is only supported by "collection of data" and "the creation of images" from the data; which is the same as creating images for different staffing levels as disclosed by Alter. Appellant argues that this limitation is patentably distinct because [*sic*] "a graphic user

interface (GUI) is used to manipulate the image". Appellant's argument suffers from two defects. **First, the feature of the claimed invention argued by Appellant is narrower than the limitation recited in the rejected claim**. In response to Appellant's argument that the references fail to show certain features of Appellant's invention, it is noted that the features upon which Appellant relies (i.e., the image is "manipulated by a graphic user interface") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). **Second, if *arguendo*, Appellant amended the claim to recite that the image is "manipulated by the graphic user interface" there is NO SUPPORT for such a limitation in the disclosure, and therefore would constitute NEW MATTER (*Emphasis Added*).**

As to argument iii), Alter fails to teach or suggest determining, according to the project business need, a number of IT sites spread over a geographic area and determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area, the Examiner respectfully disagrees. The Examiner addressed this limitation in **Claim 1** *supra*. In respect to the limitation, *according to the project business need, a number of IT sites spread over a geographic area*; Alter discloses in context of the project business need, *inter alia* on pg 564 Table 13.2 Central versus Decentral; noting "Location of hardware and data"; "corporate headquarters, regional processing centers, site processing centers (for individual factories or offices), department processors, work group processors, and

individual workstations". In respect to the limitation, *according to the project technical need, the skilled people groups and computer equipment required inside the geographic area*; Alter discloses in context of technical needs including human capital and equipment *inter alia* on pg 557 Box 13.1 "Roles of Information System Professionals"; Table 13.2 noting IS groups, hardware, software, and data locations are determined.

As to argument iv), no motivation or suggestion to combine Alter with Lacity and Willcocks, the Examiner respectfully disagrees. In response to Appellant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). As noted in **Claim 1** *supra*, "[i]t would have been obvious, at the time of the invention, to one of ordinary skill in the art to combine the feature of "physically consolidating IT sites of the geographic area to form a unique project geographic area for realizing the project business need by considering project cost parameters, distribution of the skilled people, and geographic site peculiarities, which include cultural differences, language differences, and legal constraints" taught by Lacity and Willcocks to Alter in order to facilitate the success of the IS outsourcing plan, which is a goal of Alter (see Alter p. 552)." Appellant also argues the constraints taught by Willcocks would not be considered by one of ordinary skill in the art because Willcocks is mainly

directed towards outsourcing IT. Outsourcing is one of a plurality of sourcing decisions that is considered when making a case for business, business unit, business function, etc. consolidation. Because physical consolidation through outsourcing is narrower than physical consolidation, **the narrower limitation teaches the broad claim**. However, the Examiner also disagrees with Appellant's mischaracterization of the Willcocks reference, noting that Willcocks is directed to IT site Management and Sourcing decisions, including outsourcing, insourcing, consolidation, and the like. Further noting, Willcocks explicitly discloses evaluating "consolidation" of IT business systems and units (see Figure 4 and associated text). Further, the Examiner notes that all three references Alter, Lacity and Willcocks are all directed towards the same field of invention, IT Management and sourcing and would be known to one of ordinary skill in the art, at the time of the invention. Therefore, combining the elements of Alter, Lacity and Willcocks is simply a combination of known elements yielding a predictable result; a successful IT/IS sourcing plan.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the Examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

/Brett A. Feeney/

Brett A. Feeney

Art Unit 3624

/Bradley B Bayat/

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Appendix A

10/042625	Alter	Lacity	Willcocks
Claim 1			
defining a project business need, the project business need being discrete and having a fixed duration	pg 552 "new sales tracking system"; pg 552 "when they do it to produce the specific results needed in a specific project"; page 553 "completion dates"		
defining a project technical need, the project technical need involving resources needed to realize the project business need;	pg 552 "what specific capabilities are required in each system, and second who will do what"; "firms information resources, including people, hardware and software"		
determining, according to the project business need, a number of IT sites spread over a geographic area;	pg 564 Table 13.2 Central versus Decentral; noting "Location of hardware and data"; "corporate headquarters, regional processing centers, site processing centers (for individual factories or offices), department processors, work group processors, and individual workstations"		
determining, according to the project technical need, the skilled people groups and computer equipment required inside the geographic area;	pg 557 Box 13.1 "Roles of Information System Professionals"; Table 13.2 noting IS groups, hardware, software, data locations are determined		
grouping and distributing, according to technical constraints, said skilled people groups and computer equipment over said IT sites inside the geographic area;	(see pp. 557 and 564-65; where skilled personnel and grouped in to general roles. Equipment and personnel are distributed based on technical constraints. The technical constraints include decentralized systems that account for local variances versus centralized systems that perform cross-departmental functions well		
listing processes and methods used in the IT sites as determined	see pp. 559 and 565-566; where corporate standards and procedures are determined; pg 565 "corporate standards"		
listing criteria allowing assessment of efficiency of said processes and methods in the IT sites as determined and according to the skilled people groups and computer equipment as determined, grouped, and distributed;	see pp. 570-574; where assessment of efficiency is determined using multiple standards and procedures; noting pg 574 "NPV", "IRR", "Payback" and "Cost-Benefit Analysis"		
entering in a database the values of said criteria	O/N (not traversed)	(support O/N with Data center MIPS page 382)	
creating with graphic user interface an evolutionary image of the values of the criteria	see p. 573; where a graph displaying costs, benefits and cumulative net benefit is created for a project		